

8

Docket No. CLT-100
Serial No. 09/629,241Remarks

Claims 14-16 and 18-31 were pending in the subject application. By way of this amendment, claims 14, 24, 25, and 28 have been amended, and claim 32 has been added. The applicant asserts that no new matter is introduced by this amendment. Accordingly, claims 14-16 and 18-32 are currently before the Examiner. Favorable consideration is earnestly requested.

As an initial matter, claim 14 is objected to because of an informality. The Examiner indicates that, on line 10, "areas" should read "area". The applicant gratefully acknowledges the Examiner's careful review of the claims. By this Amendment, the applicant has amended claim 14 to correct the inadvertent clerical error. Accordingly, reconsideration and removal of the objection is respectfully requested.

Claim 24 is also objected to because of an informality. The Examiner indicates that, on line 2, "via a" should read "via the". The applicant gratefully acknowledges the Examiner's careful review of the claims. By this Amendment, the applicant has amended claim 24 in accordance with the Examiner's helpful suggestion. Accordingly, reconsideration and removal of the objection is respectfully requested.

Claims 28 and 29 have been rejected under 35 U.S.C. §112, first paragraph. Claim 28 has been amended to now be written as an independent claim. The steps of claim 28 are consistent with an embodiment of the subject invention having a wire receiving area which has a means for closeably securing the wiring within the wire receiving area. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection of claims 28 and 29 under 35 U.S.C. §112.

Claims 14-16, 18-20, and 24-31 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,463,189 to Deneke *et al.* in view of U.S. Patent No. 2,109,213 to Fearing in view of U.S. Patent No. 5,141,185 to Rumbold *et al.* and further in view of U.S. Patent No. 4,538,782 to Kirschenbaum.

With respect to the rejections of claims 14-16, 18-20, and 24-31, applicant refers to the Interview Summary mailed April 28, 2003 with respect to a telephonic interview conducted on April 23, 2003 with Examiner Naschica S. Morrison and applicant's undersigned representative (James S. Parker) participating. The interview summary indicates that claims 12-14 were discussed and that

J:ASH-RESP\Misc\CLT-100-F.doc\DNB\la

"regarding claim 14, applicant and examiner discussed claim language which would read over Jacobson ... [e]xaminer agreed that Jacobson does not teach the step of positioning the wiring parallel to the length of the metal framing member."

Following the April 23, 2003 interview, in an attempt to expedite the prosecution of the subject application to a condition for allowance, applicant amended claim 14 to replace "positioning the electrical wiring along the metal framing member" with "positioning the electrical parallel to the length of the metal framing member" (underline added to emphasize change made to claim).

In response to Arguments section on page 6 of the outstanding Office Action dated July 16, 2003, the Office Action states "[a]pplicant's arguments (and amendment to claim 14), see pages 7-8, filed April 24, 2003, with respect to the rejection(s) of claims 14 and 18-20 under Reimer have been fully considered and are persuasive ... [t]herefore, the rejection has been withdrawn ... [h]owever, upon further consideration a new ground of rejection is made in view of Deneke, Fearing, Rumbold, and Kirchenbaum." Further, in the Conclusion section on page 6 of the outstanding Office Action dated July 16, 2003, the Office Action states "[a]pplicant's amendment necessitated the new grounds of rejection presented in this Office Action." As the amendment of claim 14 presented by applicant, as discussed above, did not result in an indication of allowability, new claim 32 has been added and is identical to claim 14 before such amendment. With respect to new claim 32, the applicant asserts that the Reimer reference does not teach or suggest the subject invention as claimed in new claim 32. The Reimer reference discloses a method of terminating a stripped wire to a terminal post in making an electric connection with a "V" shaped clip. The Reimer method involves pressing a spring clip over a post to address the wire against the post. The Reimer method does not attach the spring clip to the sides of a metal framing member. In contrast to the method of new claim 32 of the subject application, the method taught by the Reimer reference does not teach positioning the electrical wiring along the metal framing member, the metal framing member having a face and two sides. Rather, the method taught by the Reimer reference teaches positioning a wire over an end and down two sides of post 10, where post 10 is a single bar of metal.

In addition, the method of the Reimer reference does not teach securing the wiring to post 10 such that the wiring is centrally positioned on the "face" of post 10 between a first and a second side of post 10, but, rather, teaches securing the wire across the entire "face" of post 10 and over the edges of the "face" of post 10 and onto first and second sides of post 10. With respect to claim 18, Reimer does not teach or suggest a method for securing electrical wiring to a two-by-four metal framing member having a face and two sides with a wiring clip. With respect to claim 19, Reimer does not teach a method securing within a wire receiving area to the face of the metal framing member so as to be located at least $1\frac{1}{4}$ inches from the first side of the metal framing member and located at least $1\frac{1}{4}$ inches from the second side of the metal framing member. With respect to claim 20, Reimer does not teach or suggest a method wherein the wiring positioned within the wire receiving area is secured within the wire receiving area. Accordingly, applicant asserts a rejection of new claim 32 under 35 U.S.C. §103(a) over the Reimer reference would not be appropriate.

With respect to the rejection of claims 14-16, 18-20, and 24-31 under 35 U.S.C. §103(a) over Deneke *et al.*, in view of Fearing, in view of Rumbold *et al.*, and further in view of Kirschenbaum, the applicant respectfully traverses this grounds for rejection. Applicant respectfully submits that the rejection is the result of improper hindsight reconstruction of the claimed invention. While applicant recognizes that such a reconstruction of the invention is proper so long as an obviousness rejection takes into account only the knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure (*In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)), it is respectfully submitted that applicant's disclosure has been used to serve as the basis of the rejection currently of record. Combining prior art references without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). Additionally, the Court of Customs and Patent Appeals has stated, "[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference

teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). In the case of the presently claimed invention, it is unclear what motivation one of ordinary skill in the art would have had to apply the cited teachings without the guidance and disclosure of the presently claimed invention.

In particular, the Deneke *et al.* teaches at column 2, lines 39-58 that it is an object of the Deneke *et al.* invention to "provide a new and useful installation clip device which is used for mounting electrical cables along a structural member without having to fasten the clip device directly to the structural member ... provide an installation clip device which can be easily fastened directly to an electrical cable that is mounted along the structure member ... provide an installation clip device which can be indirectly fastened to the structural member ... an installation clip device is adapted for use with a first electrical cable that is mounted along a structural member so that a second electrical cable can be mounted therealong" (underlining added for emphasis). Therefore, the Deneke *et al.* reference does not teach or suggest "positioning the electrical wiring 12 parallel to the length of the framing member 14 and centrally locating the wiring on the face thereof, and securing the electrical wiring to the framing member by receiving the electrical wiring with a wire receiving area (see Fig. 1) of a securing member (15) and fastening the securing member to the framing member", as characterized on page 3 of the Office Action.

The Office Action, on page 4, then states, when referring to the Fearing reference that "[i]t would have been obvious to one of ordinary skill in the art ... to have substituted the wiring clip for the securing member (15)". However, (15) refers to a staple in the Deneke *et al.* reference. Accordingly, it is not clear what substitution the Office Action is referring to.

With respect to the Kirschenbaum reference the clamp taught is for "supporting a plurality of flat electrical cables in a predetermined orientation, adapted for mounting on a cross-member of an electrical inter connection frame extending in a direction perpendicular to the predetermined orientation" (underlining added for emphasis) (see claim 1, line 5-9 and Figure 1). The Office Action, at page 5, states "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wiring clip to be formed of plastic and to substitute the first and second arms for the arm (1) and locate the first and second arms so

12

Docket No. CLT-100
Serial No. 09/629,241

as to be oppositely disposed about the wire receiving area". Again, it is not clear what modification the Office Action is referring to, as neither the Deneke *et al.* nor Kirschenbaum reference show an arm (1).

The Rumbold *et al.* reference teaches away from incorporating a first arm and a second arm. In particular, the Rumbold *et al.* reference teaches a single leg 131 (col. 6, line 23; Figures 12-20) which is attached to the metal stud via sheet metal screws 150 and 151 (col. 6, line 50; Figures 12-20). The leg 131 taught by Rumbold *et al.* cannot attach to the metal stud without screws 150 and 151 or some other equivalent means.

In the case of the presently claimed invention, it is unclear what motivation one of ordinary skill in the art would have had to apply the cited teachings without the guidance and disclosure of the presently claimed invention. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a).

Claims 21-23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Deneke *et al.* in view of Fearing in view of Rumbold *et al.* in view of Kirschenbaum, and further in view of U.S. Patent No. 3,508,730 to Knezo, Jr. (Knezo). The limitations of the Deneke *et al.*, Fearing, Rumbold, and Kirschenbaum references have been discussed above with respect to the rejection of claim 14, from which claims 21-23 depend. The Knezo reference does not cure these defects. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a).

13

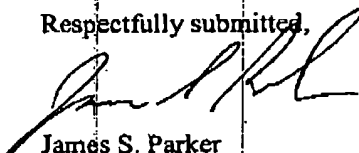
Docket No. CLT-100
Serial No. 09/629,241

In view of the foregoing, the applicant believes that all claims as currently pending are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge to Deposit Account 19-0065 any fees under 37 CFR 1.16 or 1.17 as required by this paper.

Applicant invites the Examiner to call the undersigned if clarification is needed on any of this amendment, or if the Examiner believes that a telephone interview would expedite prosecution of the subject application to completion.

Respectfully submitted,



James S. Parker
Patent Attorney

Registration No. 40,119

Phone No.: 352-375-8100

Fax No.: 352-372-5800

Address: 2421 N.W. 41st Street, Suite A-1
Gainesville, FL 32606-6669

JSP/an